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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,776	09/29/2003	Atsushi Sugasaki	Q77307	7561

23373 7590 03/09/2005
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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,776

Applicant(s)

SUGASAKI ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/18/2004 & 9/29/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 0200 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/18/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28, 30-31, 33 of copending Application No. 09/907,611. Although the conflicting claims are not identical, they are not patentably distinct from each other because based on the claims of Oshima it would have been obvious to one of ordinary skill in the art to make a photosensitive lithographic printing plate comprising a photosensitive layer containing a polymeric binder having a repeating unit represented by formula (I), an infrared absorber, a photo- or heat-polymerization initiator and a compound having an

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ethylenically unsaturated bond capable of addition polymerization with reasonable expectation of obtaining a negative working and infrared sensitive printing plate. It is the Examiner's position the printing plate claimed by Oshima has the same characteristics as the printing plate of Oshima even though Oshima is silent with respect to what happens in the various areas of the plate upon exposure. This position is based on inherency - the printing plate claimed Oshima has the same structure and same chemical components as the presently claimed single layer printing plate and for this reason is expected to function in the same way. MPEP 2112.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/669,696 (US 2004/0063034). Although the conflicting claims are not identical, they are not patentably distinct from each other because based on the claims of Goto it would have been obvious to one of ordinary skill in the art to make a planographic printing plate comprising a substrate and a photosensitive composition layer comprising a binder polymer, polymerizable compound, an infrared absorber, and a radical generator with reasonable expectation of obtaining a printing plate that is negative working and infrared sensitive. It is the Examiner's position the printing plate of Goto has the same characteristics as the printing plate of Goto even though Goto is silent with respect to what happens in the various areas of the plate upon exposure. This position is based on inherency - the printing plate of Goto has the same single layer

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structure which comprises all of the required chemical components as the presently claimed printing plate and for this reason is expected to function in the same way.

MPEP 2112.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-12, 15-20 of copending Application No. 10/673,332 (US 2004/0072101 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because based on the claims of Sugasaki et al. it would have been obvious to one of ordinary skill in the art to make a planographic printing plate comprising a substrate and a photosensitive layer comprising a binder polymer having the specific repeating unit represented by formula (I), an infrared absorbent, a polymerization initiator and a polymerizable compound with reasonable expectation of obtaining a printing plate that is negative working and infrared sensitive. It is the Examiner's position the printing plate of Sugasaki et al. has the same characteristics as the printing plate of Sugasaki et al. even though Sugasaki et al. is silent with respect to what happens in the various areas of the plate upon exposure. This position is based on inherency - the printing plate of Sugasaki et al. has the same single layer structure which comprises all of the required chemical components as the presently claimed printing plate and for this reason is expected to function in the same way. MPEP 2112.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 - 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Oshima (EP 1 176 467 A1).

a. The negative working photosensitive lithographic printing plate of Oshima meets the present limitations for the planographic printing plate precursor. Specifically the photosensitive lithographic printing plate of Oshima comprises a support, at least one photosensitive layer containing polymeric binder having repeating units represented by formula (I) (abstract; [0015]-[0035]). The polymeric binder of formula (I) meets the present limitations for the binder polymer. The photosensitive layer further comprises polymerization initiator, a compound having at least one ethylencially unsaturated bond capable of undergoing addition polymerization and an

infrared absorber when a laser infrared rays is used as the imaging light source ([0041]-[0080]). The initiator, unsaturated compound and infrared absorber meet the present limitations for the same. A heat-decomposable radical generator is used in combination with the infrared absorber ([0081]-[0088]). The sensitivity of the photopolymerizable photosensitive layer can be further improved by incorporating a co-sensitizer thereinto ([0090]). An aqueous alkali solution having a pH of 14 or lower, preferably a pH of from 8 to 12, is used as the developing solution ([0124]). It is clear from the language of the prior art that Oshima clearly envisioned a printing plate comprising more than one photosensitive layer. The printing plate comprising at least two photosensitive layers comprising the components cited above, meet the present limitations for the printing plate precursor comprising a first and second layer. It is the Examiner's position the printing plate of Oshima has the same characteristics as the printing plate of Oshima even though Oshima is silent with respect to the developing rate and what happens in the various areas of the plate upon exposure. This position is based on inherency - the printing plate of Oshima has the same structure and same chemical components as the presently claimed printing plate and for this reason is expected to function in the same way. MPEP 2112.

8. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Yanaka (US 2003/0068575 A1).

a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either

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by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

b. The lithographic printing plate of Yanaka, comprising a support and a photosensitive layer comprising an infrared ray absorbing agent, an onium salt, a radically polymerizable compound, a binder polymer and an organic dye, clearly anticipates the presently claimed printing plate (abstract). It is the Examiner's position the printing plate of Yanaka has the same characteristics as the printing plate of Yanaka even though Yanaka is silent with respect to what happens in the various areas of the plate upon exposure. This position is based on inherency - the printing plate of Yanaka has the same single layer structure which comprises all of the required chemical components as the presently claimed printing plate and for this reason is expected to function in the same way. MPEP 2112.

9. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Goto (US 2004/0063034 A1).

a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

b. The planographic printing plate of Goto, comprising a substrate and a photosensitive composition layer comprising a binder polymer, polymerizable compound, an infrared absorber, and a radical generator, clearly anticipates the presently claimed printing plate (abstract). It is the Examiner's position the printing plate of Goto has the same characteristics as the printing plate of Goto even though Goto is silent with respect to what happens in the various areas of the plate upon exposure. This position is based on inherency - the printing plate of Goto has the same single layer structure which comprises all of the required chemical components as the presently claimed printing plate and for this reason is expected to function in the same way. MPEP 2112.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. In US 2003/0162127 A1, Kikuchi teach a lithographic printing plate precursor.

b. In US 6,566,035 B1, Aoshima teach a negative-type image recording material and precursor recordable by the irradiation of an infrared ray.

c. In US 6,858,374 B2, Yanaka teach a lithographic printing plate.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-

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1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Barbara L. Gilliam
Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
March 1, 2005